

REMARKS

Claims 1, 3-5, 7-11 and 20 are now present in this case. Claims 1, 3, 4, 7-11 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 4,541,227 to Coad et al. combined with Swiss Patent No. CH 187705 to Christoffel combined with German Patent No. DE 3416710 to Lissner.

The advisory action states that the applicants previous remarks appear to be directed more to a process of using the bags rather than the claimed bag itself. However, the previous remarks were intended to show that the bags in the cited references are for processes that would not lead one of ordinary skill in the art to include the structural elements recited in the claimed invention. For example, the Office Action dated March 17, 2004 states that Coad teaches the use of a bale bag to pack multiple bags for shipping and discloses a "paper bale having a front panel, a back panel, two side panels, and a closed bottom panel." (See Office Action of March 17, 2004, page 2.) The Office Action further states that Coad is silent regarding multi-layered panels and does not teach an aperture in the back panel in a cutaway portion in the front to expose the aperture. The comments in the paper submitted by the applicants on March 24, 2004 discuss the operation of the Coad machine to illustrate that Coad has no need for an aperture in the back panel or a cutaway portion in the front panel to expose the aperture, both of which are structural elements in the claimed invention. There is no suggestion or even motivation to place a hole in the bag in Coad because the machinery operates in a totally different manner that precludes the use of an aperture, such as that recited in claim 1.

Claim 1 is directed to a commercial potato shipping container and recites *inter alia* "a multi-layer paper bale for shipping bulk quantities of potatoes and configured for use with an automated potato bale-filling apparatus, the paper bale having sufficient size to receive and sufficient strength to retain during shipping a plurality of consumer sized bags of potatoes." Claim 1 further recites "an elongated flat

back panel" (emphasis added) as well as "an aperture in the back panel proximate the top portion with the back panel having a continuous perimeter surrounding the aperture; and a cut-away portion in the front panel proximate the top portion to expose the aperture wherein the aperture is in the back panel only."

When considered in their entirety, the combination of references cited in the Office Action do not suggest the structure of claim 1. The Office Action of March 17, 2004 states that Christoffel teaches providing a paper bag with an aperture in the back panel and a cutaway portion in front panel and suggests that a combination would make the invention of claim 1 obvious. However, Christoffel teaches directly away from the claimed invention by disclosing bags containing a vertical crease from top to bottom resulting in a folded back panel. The structure recited in claim 1 (i.e., an elongated flat back panel with an aperture having a continuous perimeter surrounding the aperture) is not suggested by the combination of references. Even if one were to combine the references in the manner suggested in the Office Action, the folded bags of Christoffel, which are clearly intended for manual use, would not operate in automated machinery, such as that recited in claim 1. Lissner is cited for teaching the use of multiple paper layers. The fragmentary analysis of Lissner ignores the arrangement of the multiple layers that makes it impossible to include an aperture without destroying the functionality of the bag in Lissner. The multiple incisions in the layers (see English language abstract) will not function in the intended manner if an aperture were placed through the multiple layers as suggested in the Office Action. A consideration of Lissner in its entirety shows that it teaches away from the claimed invention by disclosing multiple slits in a multiple layered bag. Accordingly, claim 21 is clearly allowable over this combination of references cited in the Office Action.

Claim 20 recites *inter alia* "first and second opposing panels having an unfolded upper portion" (emphasis added) as well as "an aperture in the unfolded upper portion of the first opposing panel proximate the top portion with the first opposing panel having a continuous parameter surrounding the aperture, the aperture sized to slideably fit onto the protruding member." Claim 20 further recites "a cut-away portion in the

second opposing panel proximate the top portion to expose the aperture wherein the aperture is in the first opposing panel only." As discussed above with respect to claim 1, the combination of references do not suggest the structures recited in claim 20. Specifically, Coad discloses a bag with no aperture that is contained within a mechanical frame in a horizontal configuration. The entire loading process in Coad occurs with the bag in a horizontal configuration. Thus, there is absolutely no need or suggestion to modify the bag of Coad to have an aperture in it as suggested by the Office Action. If one were to combine Coad and Christoffel, the result would be a folded bag with a hole that is unnecessary for operation in the machinery of Coad and unsuitable for automated operation. As noted above, the addition of Lissner to the combination of Coad and Christoffel does not result in the claimed invention. If one were to place an aperture in the bag of Lissner in the manner suggested in the Office Action, the bag of Lissner would no longer function in its intended manner. In addition, the slits in the various layers in Lissner may be proximate the perimeter surrounding the aperture, which teaches directly away from the claimed invention. Accordingly, claim 20 is clearly allowable over the cited references.

Motivation to combine references

There are no suggestions in any of the cited references that would lead to the combination reached in the Office Action of March 17, 2004. The Advisory Action dated April 14, 2004, states that "any judgment of obviousness is in a sense necessarily a reconstruction based on hindsight reasoning. But so long as it takes into account only knowledge that was within the level of ordinary skill at the time of the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper." This is similar to the language used by the Board of Patent Appeals and Interferences in a recent case where the Board stated that "the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Lee* 61 USPQ.2d 1430, 1432 (Fed. Cir.

2002). In overruling the Board, the Federal Circuit stated that "our case law makes it clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Id.* at 1433, citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ.2d 1614, 1617 (Fed. Cir. 1999). The Court further stated that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *Id.*, citing *In re Kotzab* 217 F.3d 1365, 1371, 55 USPQ.2d 1313, 1317 (Fed. Cir. 2000).

In the present case, there is no suggestion or motivation to combine the references in the manner suggested in the Office Action. The Office action provides no findings as to why such a combination would be made. The Examiner has the burden of showing obviousness of the combination by "showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *Id.* at 1434, citing *In re Fritch* 972 F.2d 1260, 1265, 23 USPQ.2d 1780, 1783 (Fed. Cir. 1992). In addition, it should be noted that the declaration of Mark L. Johnson, submitted May 1, 2003 provides an indication of the difficulty faced by those of ordinary skill in the art. The declarant, who is not an inventor, but has more than 40 years experience in produce packing operations, describes decades-long efforts to automate the industry, including the efforts of his own company for more than a year and a half to find a shipping bale suitable for automated operation. Those efforts ended in failure. The three references cited in the Office Action were all available to the declarant and to others of ordinary skill in the art. However, despite years of effort to achieve the bale bag suitable for automated use, nobody achieved the desired result until the introduction of the claimed invention.

References must be considered in their entirety

A reference must be considered for all that it teaches, including disclosures that diverged and taught away from the invention as well as disclosures that point towards and taught the invention. Ashland Oil, Inc. v. Delta Resins and Refractories, Inc., 776 F.2d 281, 227, USPQ 657, 666 (Fed. Cir. 1985) citing W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1550, 220 USPQ 303, 331 (Fed. Cir. 1983), *cert denied* 105 S. Ct. 172 (1984). In the present case, the cited references have been selectively considered only for elements that, in the Examiner's opinion, suggest the claimed invention. Specifically, Coad discloses a shipping container that is mounted horizontally in a rack and is extracted, opened, and loaded while maintaining the bag in the horizontal orientation. This teaches directly away from the claimed invention in which an aperture is placed in the top portion of the bag. Given the horizontal orientation of bags in Coad, one would not be led to introduce an aperture in a bag at a location that is completely unnecessary. Similarly, Christoffel discloses a consumer bag for manual operation which has a vertical crease from top to bottom through the aperture and is mounted on a triangular block on a wall to maintain that folded shape. The vertical fold in the bag of Christoffel is critical to its function. Indeed, Christoffel states that "in order for the paper bags, that have been bundled together and folded at an angle, to retain their shape it is important to hang them on a nail over a three-sided block (8) on the wall or over the edge of a piece of furniture, etc." (See Christoffel, page 2, emphasis added.) As noted above, the present invention recited in claim 1 includes *inter alia* "an elongated flat back panel" (emphasis added). Similarly, claim 20 recites *inter alia* "first and second opposing panels having an unfolded upper portion" (emphasis added). Thus, Christoffel teaches directly away from the claimed invention having an unfolded upper portion or a flat back panel. The Examiner has ignored this aspect of Christoffel.

Lissner is directed to a multi-layered paper sack in which each of the layers "starting from the lowest layer, projecting beyond the respective higher layer in the manner of steps in the longitudinal direction of the sack in the region of the opened

end." (See Abstract of Lissner.) Lissner also discloses that at least some of the layers are "each to have two incisions which are arranged spaced apart and extend in the longitudinal direction of the sack, starting from the free end of the respective connecting portion, up to the free edge of the first connecting portion without an incision, and the incisions of the respective higher connecting portion are to be arranged offset toward the center of the sack." (See Abstract of Lissner.) The offset layered arrangement of Lissner teaches away from the claimed invention because a hole through the multiple layers of Lissner, as suggested in the Office Action, would destroy the functionality of the bag in Lissner. In addition, the incisions described in Lissner teach away from the claimed invention which recites, in claim 1, "an aperture in the back panel proximate the top portion with the back panel having a continuous perimeter surrounding the aperture; and a cut-away portion in the front panel proximate the top portion to expose the aperture wherein the aperture is in the back panel only." An aperture in the back panel of the bag in Lissner would go through multiple layers. Because of the offset nature of the layers in Lissner a cut-away portion in the front panel would be at some distance from the aperture in the back panel and would not serve to expose the aperture; as recited in claim 1. Claim 20 contains a similar recitation. The Examiner has ignored these aspects of Lissner and focuses in only on multiple layer aspect of Lissner. Such selective analysis of prior art is clearly prohibited.

Secondary considerations as indicators of non-obviousness

The applicants have submitted the declaration of Mark L. Johnson to provide objective evidence of non-obviousness. "Obviousness is ultimately a question of law that rests on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) The differences between the claimed invention and the prior art; and (4) objective considerations of non obviousness." Graham v. John Deere Company, 383 U.S. 1, 17 (1966). The objective evidence of non-obviousness in the Johnson declaration include the long-felt need and failure by others to solve the problem and commercial success of the invention,

including copying by others. "Objective considerations such as a failure by others to solve the problem and copying may often be the most probative and cogent evidence of non-obviousness." Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) quoting Graham v. John Deere, 383 U.S. at 17-18. The declarant, who is not an inventor, has been involved in the produce packing industry since the 1960s. (See Johnson Declaration, page 1.) The declarant described decades of efforts to automate the packaging process, including his own attempt for approximately one and a half years, to design an automated system. The declarant further describes difficulties in bag design that led to the failures to develop an automated system. (See Johnson Declaration, pages 2-3.) The long-felt need and failure of others to design a suitable shipping bale for use in an automated process provides strong objective evidence of non-obviousness.

The claimed invention has enjoyed great commercial success and copying by others. "Since its introduction, virtually all paper bales manufactured in the United States and Canada are made in accordance with the teachings of the pending patent application and the paper bales have experienced great acceptance and commercial success." (See Johnson Declaration, page 4.) "The claimed invention has been used in a variety of different machine designs and has been found to have the desirable characteristics of the bale, and to be useful in an automated process." (See Johnson Declaration, page 4.) That fact that the claimed bale may be used with different machines demonstrates that it is the characteristics of the inventive bale that have been key to the automation process and that different machines can be designed to take advantage of the claimed bale. The fact that the inventive bale has been copied by virtually all manufacturers in the United States and Canada provides strong objective evidence of non-obviousness. Prior to the introduction of the claimed invention no paper bales were manufactured in accordance with the claimed invention. In the opinion of the declarant, "the commercial success has resulted directly from the invention claimed in the pending application." (See Johnson Declaration, page 4.)

In the opinion of the declarant, "attempts to automate the process have been unsuccessful in the past because of a lack of a suitable shipping container. The introduction of the claimed bale enabled the development of multiple different machine designs that utilize the claimed bale." (See Johnson Declaration, page 5.)

Conclusion

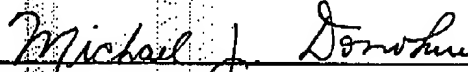
There has been no showing of motivation to combine the references in the manner suggested in the Office Action. The references themselves provide no such suggestion. While the references are all directed to different forms of bags, the different intended applications for each bag result in different design characteristics for each bag. The differing design characteristics decrease the likelihood that one skilled in the art would combine only selected aspects of the references, also the overall teachings of the references and ignore elements that teach away from the claimed invention to achieve the claimed invention.

When the cited references are considered in their entirety, the claimed invention is not fairly suggested by the total teachings in the three cited references (*i.e.*, Coad, Christoffel and Lissner.) Each of the references, when considered in its entirety, teaches away from the claimed invention. For example, Coad discloses bags in a horizontal configuration in a magazine rack that are never placed in a vertical orientation during the extraction or loading process. Christoffel discloses a bag with a vertical crease that is critical to the invention and, because of that crease, makes it unsuitable for automated operation. Lissner discloses multiple layers that make it unsuitable for placement of a whole. When properly considered, the combination of references do not suggest the claimed invention.

In addition, the declaration of Mark L. Johnson provides details of the long-felt need and unsuccessful attempts to develop shipping bales useful in an automated process. The declarant points to the widespread acceptance and commercial success of the shipping bale in a variety of different machines. The commercial success of the claimed bale is strong secondary indicia of patentability.

The applicants kindly request a reconsideration of the pending application and its allowance.

Respectfully submitted,
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